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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,336	02/01/2001	Swinton B. Burkhalter	101	9210

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Joseph H. Golant
77 West Wacker Drive, Suite 3500
Chicago, IL 60601-1692

EXAMINER

COBANOGU, DILEK B

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/775,336	Applicant(s) BURKHALTER ET AL.	
	Examiner Dilek B. Cobanoglu	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/14/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the Request for Continued Examination (RCE) filed on 11/28/2006. Claims 1-16 have been cancelled and claims 17-36 are newly added.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sexton et al. (hereinafter Sexton) (U.S. Patent No. 5,752,236) in view of Libman (U.S. Patent No. 5,987,434).

A. As per claim 17, Sexton discloses a method for forming an insurance plan comprising the steps of

- i. collecting base product data (Sexton; col. 8, line 63 to col. 9, line 9);
- ii. inputting the base product data into a data processing system (Sexton; col. 8, line 63 to col. 9, line 9);
- iii. collecting data relating to an individual to be insured (Sexton; col. 13, lines 62-66, col. 17, lines 60-65);
- iv. inputting the data about the individual into a data processing system (Sexton; col. 13, lines 62-66, col. 17, lines 60-65);

- v. collecting governmental regulatory requirements relating to life insurance and non life insurance (Sexton; col. 10, lines 41-51);
- vi. inputting the governmental regulatory requirements into a data processing system (Sexton; col. 10, lines 41-51);
- vii. inputting life insurance information into the data processing system (Sexton; col. 17, lines 49-59);

Sexton fails to expressly teach a non life insurance coverage, such as disability insurance. However, this feature is well known in the art, as evidenced by Libman.

In particular, Libman discloses a non life insurance coverage, such as disability insurance (Libman; col. 9, lines 50-63).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Libman with the motivation of meeting the needs of the client (Libman; col. 9, lines 50-57).

- viii. thereafter constructing in a data processing system from the life insurance information and the non life insurance information two related insurance policies, one of the two related policies being a life insurance policy and the other of the two related policies being a non life insurance policy, each of the two related policies having a premium obligation based on expenses and profits which together results in a total premium obligation, a total expense and a total profit wherein the total expense is

allocated more heavily to an owner of the non life insurance policy so as to favor an owner of the life insurance policy (Sexton; col. 8, lines 42-45, col. 11, lines 4-10);

ix. thereafter qualifying the life insurance policy and non life insurance policy with the governmental regulatory requirements (Sexton; col. 7, lines 28-37); and

x. displaying the resulting related two insurance policies (Sexton; col. 13, lines 39-42):

B. As per claim 18, Sexton discloses the method as claimed in claim 17 including the step of: allocating total profits more heavily to the owner of the non-life insurance policy so as to favor the owner of the life insurance policy (Sexton; col. 11, lines 4-10).

C. As per claim 19, Sexton discloses the method as claimed in claim 17 including the step of: allocating total premium obligation more heavily to the owner of the non-life insurance policy so as to favor the owner of the life insurance policy (Sexton; col. 11, lines 4-10).

D. As per claim 20, Sexton discloses the method as claimed in claim 17 wherein: the step of qualifying the life insurance policy and non life insurance policy with the governmental regulatory requirements includes the further steps of testing the life insurance policy and the non life insurance policy against the governmental regulatory requirements, and thereafter altering the allocation of the total expense between the owners of the life insurance policy and non life

insurance policy until the life insurance policy and the non life insurance policy qualify under the governmental regulatory requirements (Sexton; col. 7, lines 44-52, lines 62-64).

E. As per claim 21, Sexton discloses the method as claimed in claim 20 wherein: the step of qualifying the life insurance policy and the non life insurance policy with the governmental regulatory requirements includes the further step of maximizing the allocation of the total expense to the owner of the non life insurance policy while complying with government regulatory requirements and minimizing the allocation of the total expense to the owner of the life insurance policy (Sexton; col. 11, lines 4-10).

F. As per claim 22, Sexton discloses the method as claimed in claim 17 wherein: the base product data includes the probability of an event insured against occurring, the time value of money, the benefits promised, company expenses, company profits and probable contingencies (Sexton; col. 9, lines 32-40).

G. As per claim 23, Sexton discloses the method as claimed in claim 17 wherein: the data relating to an individual to be insured includes information concerning one or more of the following subjects: his/her sex, age, marital status, individual medical history, family medical history, usage of alcohol, tobacco and drugs, automobile driving record, credit report, financial statement, criminal record, current medical examination report and results, and physical disabilities and impairments (Sexton; col. 13, lines 62-66, col. 17, lines 60-65).

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H. As per claim 24, Sexton discloses the method as claimed in claim 17 wherein: the life insurance information is chosen from among the following coverages including whole life, interest sensitive whole life, universal life, variable universal life and term life (Sexton; col. 10, lines 10-22).

I. As per claim 25, Sexton discloses the method of claim 21 wherein:

- i. the base product data includes the probability of an event insured against occurring, the time value of money, the benefits promised, company expenses, company profits and probable contingencies (Sexton; col. 9, lines 32-40); and
- ii. the data relating to an individual includes information concerning one or more of the following subjects: his/her sex, age (Sexton; col. 13, lines 62-66, col. 17, lines 60-65)

J. As per claim 26, Sexton discloses the method as claimed in claim 25

including the step of: adding a rider or riders and/or an option or options to the life insurance policy or the non life insurance policy or to both of the policies, such riders including one or more coverage from the group of riders including accidental death dismemberment, waiver of premium in event of disability, spousal and children life insurance, guaranteed insurability option for additional insurance, exchange of insured rider, and return of premiums rider for disability and long term care (Sexton; col. 7, lines 38-43).

K. As per claim 27, Sexton discloses the method as claimed in claim 26 wherein: the life insurance product is chosen from among the following coverages

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including whole life, interest sensitive whole life, universal life, variable universal life and term life (Sexton; col. 17, lines 49-59).

L. As per claims 28-36, they are system claims, which repeat the same limitations of claims 17-27, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Sexton and Libman disclose the underlying process steps that constitute the methods of claims 17-27, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 28-36 are rejected for the same reasons given above for claims 17-27.

Response to Arguments

4. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach Computer system for automated comparing of universal life insurance policies based on selectable criteria 5655085 A; Computer apparatus and method for generating documentation using a computed value for a claims cost affected by at least one concurrent, different insurance policy for the same insured 6163770 A, System and method for facilitating selection of

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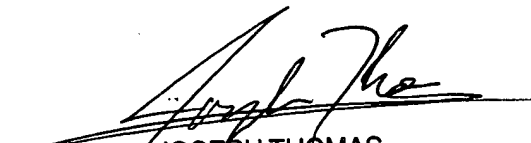
benefits 2002/0049617, System for appraising a financial product 20020091613, Apparatus and method for exposing, evaluating and re-balancing risk for decision-making in financial planning 6684190 B1.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC
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Art Unit 3626
01/02/2007


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER